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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/824,219	04/13/2004	Shumpei Kawasaki	101-9409J	6297

7590 08/17/2006

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EXAMINER
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CHANKONG, DOHM

ART UNIT	PAPER NUMBER
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2152

DATE MAILED: 08/17/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No. 10/824,219	Applicant(s) KAWASAKI ET AL.	
	Examiner Dohm Chankong	Art Unit 2152	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 25 May 2006.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 17-22 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 17-22 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

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### DETAILED ACTION

1> This action is in response to Applicant's request for continued examination. Claim 17 is amended. Claims 17-22 are presented for further examination.

2> This is a non-final rejection.

#### *Continued Examination Under 37 CFR 1.114*

3> A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 5.25.2006 has been entered.

#### *Response to Arguments*

##### I. Response to Applicant's amendment and arguments

Applicant's amendment is directed at limiting the operation modes within the claims by clarifying that the operation modes are of the data processor. This amendment was introduced in light of Applicant's assertion that the primary art reference, Uchiyama, discloses operation modes that determine the operation of a synchronous DRAM. Applicant also introduces an amendment in the preamble of the claim limiting the data processor such that it is formed on a single chip. Applicant's arguments and amendment filed 5.25.2006 have been fully considered but they are not persuasive for the following reasons.

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A. Applicant's specification contradicts and does not support Applicant's amendment and argument concerning the operation modes

During patent examination, the pending claims must be given their broadest reasonable interpretation consistent with the specification. In re Hyatt, 211 F.3d 1367, 1372 (Fed. Cir. 2000). Additionally, the first paragraph of 35 U.S.C. 112 requires that the specification shall contain a written description of the invention. MPEP §2163(I). To satisfy the written description requirement, a patent specification must describe the claimed invention in sufficient detail that one skilled in the art can reasonably conclude that the inventor had possession of the claimed invention. Id.

Here, Applicant's amendment is given its broadest reasonable interpretation consistent with the specification. Applicant's amendment states: "...the plurality of operation modes comprise operation modes of the data processor." Applicant argues that the new amendment overcomes Uchiyama by limiting the operation modes of the claim to operation modes of a data processor. However, Applicant's argument is expressly contradicted and unsupported by Applicant's specification.

When discussing Applicant's specification, this action refers to Applicant's published publication, 2004/0199716. Applicant's specification expressly states:

"A further representative of the invention to be disclosed herein will be briefly described in the following. Specifically, the external bus interface is equipped with a memory control signal generator for generating a control signal necessary for setting the operation mode of the synchronous dynamic type RAM by using an address signal..." (emphasis added) [0027].

Additionally, Applicant's specification goes on to summarize the different operation modes of the SDRAM, including the three modes that are claimed in claim 1 [0283-0301]. Indeed, Applicant's specification is silent as to the operation modes comprising operation

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modes of a data processor and only discusses operation mode of the SDRAM, as described in Uchiyama's invention.

Thus, based on Applicant's specification, the Office interprets Applicant's claimed operation modes as being operation modes of an SDRAM. Based on this interpretation, Uchiyama's teaching discloses Applicant's claimed operation modes. Applicant's amendment therefore does not overcome the prior art reference.

B. Uchiyama discloses a data processor formed on a single chip

Applicant amends claim 17 with language directed towards a data processor formed on a single chip to overcome Uchiyama. However, Uchiyama discloses a data processor that is on a single chip [column 3 «lines 5-8»].

II. Conclusion

Based on the foregoing remarks, Applicant's amendment and remarks are not persuasive. The claim rejections set forth in the final rejection, filed 1.27.2006, are maintained.

*Claim Rejections - 35 USC § 112*

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4> Claims 17-22 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the

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relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Applicant's amendment is directed towards operation modes comprising operation modes of the data processor. However, Applicant's specification only discusses operation modes with respect to SDRAM [see Applicant's published publication 0027, 0276, 0283-301]. Thus, Applicant's amendment is not described in the specification in such a way as to convey to one skilled in the art that Applicant had possession of the claimed invention.

#### *Claim Rejections - 35 USC § 102*

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5> The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action. See previous final rejection, filed 1.26.2006, for claim rejections.

6> Claims 17-22 are rejected under 35 U.S.C. 102(e) as being anticipated by Uchiyama, U.S Patent No. 5,574,876.

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The applied reference has a common assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

### *Conclusion*

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dohm Chankong whose telephone number is 571.272.3942. The examiner can normally be reached on Monday-Thursday [7:30 AM to 4:30 PM].

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Bunjob Jaroenchonwanit can be reached on 571.272.3913. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service

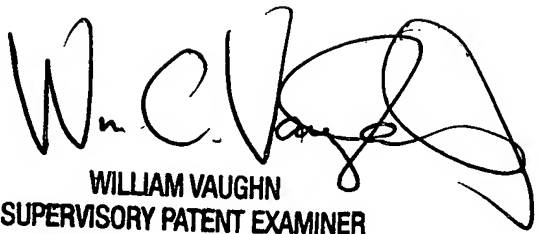
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Representative or access to the automated information system, call 800-786-9199 (IN USA  
OR CANADA) or 571-272-1000.

DC



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